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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/065,063	09/13/2002	Karin Spalink	U01-0043(15)	2602
54494	7590	05/23/2006	EXAMINER	
MOORE AND VAN ALLEN PLLC FOR SEMC P.O. BOX 13706 430 DAVIS DRIVE, SUITE 500 RESEARCH TRIANGLE PARK, NC 27709			ABEL JALIL, NEVEEN	
			ART UNIT	PAPER NUMBER
			2165	

DATE MAILED: 05/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/065,063

**Applicant(s)**

SPALINK ET AL.

**Examiner**

Neveen Abel-Jalil

**Art Unit**

2165

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on April 25, 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-14 and 16-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 and 16-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### **Remarks**

1. The Amendment filed on 4/25/2006 has been received and entered. Claim 15 has been cancelled. Therefore, claims 1-14, and 16-27 are now pending.
2. Applicant's amendment has overcome the 112, second paragraph rejection.

### ***Claim Objections***

3. Claim 13 is objected to because of the following informalities:

Claim 13, line 3, recite "if" which is optional recitation indicating the limitation following never having to take place and thus the step of the claim not to carry any patentable weight. Claim should be amended to recite more direct and definite language such as "when" or "wherein" or "is".

### ***Claim Rejections - 35 USC § 101***

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 1, 4, and 13 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 1, 4, and 13 are not statutory because they merely recite a number of computing steps without producing any tangible result and/or being limited to a practical application (see MPEP 2106 IV.B.2.(b)). The definitions given in the specification for a device is broad enough so as to not include a practical application, and no

tangible, useful, and concrete result is produced in the claims. The use of a computer or a computer processor has not been indicated.

These claims do not indicate use of computer hardware on which the software runs to perform the steps recited in the body of the claim. Software or program can be stored on a medium and/or executed by a computer. In other words the software must be computer-readable. Furthermore, there is no computer hardware or storage tied to the claimed steps in order to realize their functionality.

To overcome this type of 101 rejections, claims should be amended to recite, “A computer implemented method”.

6. Claims 25, 26, and 27 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Although reciting computer-readable medium having computer-executable instructions” in the preamble, the instruction are never executed, processed, or run on a computer in order to realize their functionality. Therefore never actually take place.

Furthermore, claims 25, 26, and 27’s preamble recite “instructions **for** performing” is intended use and does not cause any functionality to occur in the computer since it lacks combination with hardware to realize the functionality. The limitations following the phrase “**for**” describes only intended use but not necessarily required functionality of the claim. Limitations following the phrase “**for**” do not carry patentable weight, which cause the claims to appear as a series of non-functional descriptive material/data without any functional relation with each other. Applicant is required to amend the claims so that the claim limitations are recited in a definite form.

To overcome this type of 101 rejections, claims should be amended to recite, “computer-executable instructions, when executed or processed on a computer performs a method, comprising ”.

7. Claims 13, 20, and 25 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 13 is not statutory because it merely recite a number of computing steps without producing any tangible result and/or being limited to a practical application (see MPEP 2106 IV.B.2.(b)). The claims should entail transformation of article or material to a different state or thing with final results achieved “useful, tangible, and concrete” using a computer/hardware. The claims should be amended so that some kind of output is required and/or so a tangible result is produced.

For instance, in claim 13, the last “searching” step does not produce a real world results/output. Results of “searching” should be outputted, presented, accessed, or displayed in order to be tangible outcome. Independent claims 20, and 25 recite similar limitations and therefore carry the same deficiency.

#### ***Claim Objections***

8. Although no rejections in view of prior art are made, no claims in this application will be indicated as allowable until after a response to this action has been reviewed, as to the fact that certain changes may not produce allowable claims.

#### ***Response to Arguments***

9. Applicant's arguments with respect to claims 1-14, and 16-27 have been considered but are moot in view of the new ground(s) of rejection.

### Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Neveen Abel-Jalil whose telephone number is 571-272-4074. The examiner can normally be reached on 8:30AM-5: 30PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Gaffin can be reached on 571-272-4146. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Neveen Abel-Jalil  
May 17, 2006